

**REMARKS**

The Applicant notes the claim 18 is drawn to a non-elected species and is withdrawn from further consideration. The Applicant will request reinstatement of claim once a generic claim is indicated as being allowable.

The specification is objected to for the reasons noted in the official action—page 13 should be deleted. The above requested specification amendment is believed to overcome all of the raised informalities concerning this case. If any further amendment to the specification is believed necessary, the Examiner is invited to contact the undersigned representative of the Applicant to discuss the same.

Claim 24 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons noted in the official action. The inadequate written description rejection is acknowledged and respectfully traversed in view of the following remarks.

Claim 24 is canceled, without prejudice, from this application thereby overcoming the raised rejection.

Claims 13-17 and 19-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons noted in the official action. The rejected claims are accordingly amended, by the above claim amendments, and the presently pending claims are now believed to particularly point out and distinctly claim the subject matter regarded as the invention, thereby overcoming all of the raised § 112, second paragraph, rejections. The entered claim amendments are directed solely at overcoming the raised indefiniteness rejection and are not directed at distinguishing the present invention from the art of record in this case.

In particular, independent claim 13 is amended to overcome the 35 U.S.C. § 112, second paragraph rejection. As suggested by the Examiner, claim 13 is amended to specify that at least one of the first group of the shift elements is engaged during an up-shift.

Next, claim 13 is rejected, under 35 U.S.C. § 102(b), as being anticipated by Zaiser et al. '431. The Applicant acknowledges and respectfully traverses the raised anticipatory rejection in view of the following remarks.

Zaiser et al. '431 relates to an automatic shifting device of a multi-path toothed-wheel gear change box. The automatic shifting device appears to have a pair of power shift clutches 25, 26 as well as three double gearwheel clutches 19, 20, 21. During transfer of power to the transmission at least one of the power shift clutches 25, 26 is always engaged and at least one of the three double gear wheel clutches 19, 20, 21 is also always engaged (see Figs. 2 and 3). This is in contrast to the claims of the current application in which during up shifts only the second group of control elements A, D are selectively disengaged. In other words, at least in the sixth gear, i.e., the highest gear, neither one of the two positive locking shift control elements A, D is engaged. Additionally at least one of the first group of control elements is engaged during each up shift from first gear. That is, for first gear, i.e., the lowest gear, none of the first group of shift elements is engaged but for each next higher gear only one other control element of the first group of is engaged.

In addition, both of the types of clutches of Zaiser et al. '431 are friction type clutches which depend on friction to bring the clutch elements into torque transferring engagement. This is in direct contrast to the current application which claims use of two groups, namely, frictional type elements and positively engaging type elements. That is, the presently pending claims require a first group of shift elements which are frictional shift control elements, i.e., multiple disc couplings or multiple disk brakes, and a second group of shift elements which are positively locking shift elements, i.e., claw couplings and synchromesh devices.

Claims 13-16 and 19-24 are rejected, under 35 U.S.C. § 102(e), as being anticipated by Sefcik '596. The Applicant acknowledges and respectfully traverses the raised anticipatory rejection in view of the following remarks.

Sefcik '596 relates to a dual input clutch planetary transmission which includes a first group of shift control elements, i.e., the frictional clutches 18, 20, and a second group of shift control elements, i.e., the synchronizer clutches or mechanical clutches 26, 28, 30, 32, 34. During transfer of power to the transmission at least one of the frictional clutches 18, 20 is always engaged and at least one of the synchronizer clutches or mechanical clutches 26, 28,

30, 32, 34 is also always engaged (see Figs. 3 and 4). This is, in contrast to the presently pending claims in which during up shifts, only the second group of control elements A, D are selectively disengaged. In other words, at least in the sixth gear, i.e., the highest gear, neither one of the two positive locking shift control elements A, D is engaged. Additionally at least one of the first group of control elements is engaged during each up shift from first gear. That is, for first gear, i.e., the lowest gear, none of the first group of shift elements is engaged but for each next higher gear only one other control element of the first group of is engaged.

In order to emphasize the above noted distinctions between the presently claimed invention and the applied art, the independent claims of this application now recite the features of "a first group of the shift control elements (B, C, E; F, G, H, K) being frictional shift control elements with at least one of the first group of the shift control elements being engaged for an up-shift from first gear, and a second group of the shift control elements (A, D; L, M), which are positive-locking shift control elements, and for engagement of first gear, only two of the positive-locking shift control elements (A, D; L, M) of the second group are engaged, and for upshifts from first gear the positive-locking shift control elements (A, D; L, M) are only selectively disengaged." Such features are believed to clearly and patentably distinguish the presently claimed invention from all of the art of record, including the applied art.

New independent claim 25 recites the features of "a first group of the shift control elements (B, C, E; F, G, H, K) being frictional shift control elements and a second group of the shift control elements (A, D; L, M) being positive-locking shift control elements; for engagement of first gear, only two of the positive-locking shift control elements (A, D; L, M) of the second group are engaged, and for each sequential upshift from first gear, (1) only two of the shift control elements (A to E; F, G, H, I, K, L, M) are engaged, (2) only a single previously engaged shift control element (A to E; F, G, H, I, K, L, M) remains engaged for a next subsequent higher gear, and (3) the other previously engaged shift control element (A to E; F, G, H, I, K, L, M) is

disengaged and only one other shift control element (A to E; F, G, H, I, K, L, M) is engaged for the next subsequent higher gear."

New independent claim 33 recites, in addition to all of the above noted features of claim 25, the additional features of "during each down-shift from a highest gear to the first gear, only the frictional shift control elements of the first group of the shift control elements (B, C, E; F, G, H, K) being disengaged." Such features are believed to clearly and patentably distinguish the presently claimed invention from all of the art of record, including the applied art.

Claim 17 is rejected, under 35 U.S.C. § 103(a), as being unpatentable over Zaiser et al. '431 in view of Bender '148. The Applicant acknowledges and respectfully traverses the raised obviousness rejection in view of the following remarks.

The Applicant acknowledges that the additional references of Bender '148 may arguably relate to the feature indicated by the Examiner in the official action. Nevertheless, the Applicant respectfully submits that the combination of the base reference with this additional art still fails to in any way teach, suggest or disclose the above distinguishing features of the presently claimed invention. As such, all of the raised rejections should be withdrawn at this time in view of the above amendments and remarks.

If any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

In view of the above amendments and remarks, it is respectfully submitted that all of the raised rejections should be withdrawn at this time. If the Examiner disagrees with the Applicant's view concerning the withdrawal of the outstanding rejections or applicability of the Sefcik '596, Zaiser et al. '431 and/or Bender '148 references, the Applicant respectfully requests the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying

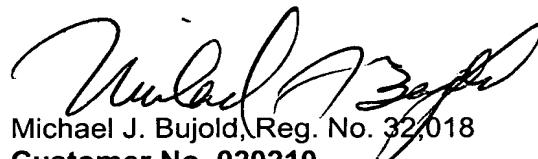
on his/her expertise in this field, the Applicant respectfully requests the Examiner to enter an affidavit substantiating the Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicant.

In view of the foregoing, it is respectfully submitted that the raised rejection(s) should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicant at this time.

The Applicant respectfully requests that any outstanding objection(s) or requirement(s), as to the form of this application, be held in abeyance until allowable subject matter is indicated for this case.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,



Michael J. Bujold, Reg. No. 32,018

**Customer No. 020210**

Davis & Bujold, P.L.L.C.

Fourth Floor

500 North Commercial Street

Manchester NH 03101-1151

Telephone 603-624-9220

Facsimile 603-624-9229

E-mail: [patent@davisandbujold.com](mailto:patent@davisandbujold.com)